

determined at step (a,ii), said profile of each said component body part of said composite body part so that said composite body part has at most one profile that describes an estimated capacity of said composite body part over time, and

wherein said combined profile from step (a,xii) is said applicable selected profile at step (a,vii) for said composite body part to which said combined profile applies.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, applicant requests that this be considered a petition therefore. Please charge the required Petition fee to Deposit Account No. 03-1240.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 03-1240.

REMARKS

Favorable reconsideration of this application, as amended herein, is respectfully requested. Claims 2, 17, 32 and 70 are deleted by this amendment. Claims 1, 2-16, 18-31, 33-69 and 71-86 remain in the application.

1. Rejection under 35 U.S.C. § 101

In the Office Action dated December 17, 2004, the Examiner rejected claims 1-86 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The applicant respectfully disagrees with Examiner's analysis and points out that the claimed

invention (a) is within the technological arts, and does not claim mere abstract ideas; and (b) applies, uses and advances the technological arts to produce a useful, concrete and tangible result.

As a general principle, section 101 excludes from patentability "merely abstract ideas constituting disembodied concepts or truths that are not 'useful'". *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ 2d 1596, 1601 (Fed. Cir. 1998). The claimed computerized system for assessing and analyzing medical conditions and medical impairment affecting medically injured person is not such disembodied concept, but are rather a useful physical application that utilizes advanced computer technology, database, data processing and data storage devices to simplify and process more effectively large amount of medical data and medical history for different patients in order to significantly improve, simplify and make less costly the insurance adjustment process, assessment of recovery, analysis and estimation of the expected timescale for the recovery for individual body parts and for the person as a whole, and assessment and estimation of impairment level throughout the recovery period. (See Specification, page 1, line 18 - page 3, line 17; pages 6-9.) The computerized system and method of the current invention significantly improves and reduces processing and assessment costs involved in the task of claim adjustment, which translates to lower costs to the insurer and employer (and possibly to the employee). This, of course, is a useful, concrete, tangible result of utilizing the computerized system/method of the current invention.

As discussed in prior office action responses, the current invention is directed to assessing the monetary value of a personal injury claim in terms of current and future pain and suffering and loss of amenities of life, or evaluation of the current and future prospects of returning to work for an injured worker. Thus, current medical conditions and impairments of an individual are evaluated in terms of their prospective effect on the following:

- The pain and suffering associated with the current injuries, treatments and complications
- The prognostic outcome and rehabilitation potential
- The impact of sustained injuries and affecting conditions on the amenities of life (mobility, dexterity, seeing, eating, etc)
- The impact of sustained injuries and affecting conditions on the occupation and resulting loss of income

Because in the claim assessment system of the current invention the time element is a key component in modelling and determining the above factors, the body parts of the entire human body are modelled in a progressive time line from the date of injury to the point of reaching a complete medical stabilization. Also, the activities in which a person engages in the current invention relate to the job-related tasks, and are evaluated in terms of the injured person's ability to engage in those activities as the sustained body impairments or injuries change with time. (See Specification pages 13-14.)

It should also be noted that the specific data structures and data organization suggested by the current invention for practicing and processing the claimed system/method using a computer have been confirmed by the Federal Circuit ruling of *In re Lawry*, 32 F.3d 1529, 32 USPQ 2d 1031 (Fed. Cir. 1994). There, the Federal Circuit held that the element of a data structure in a claim was not an abstraction analogous to written material, but, rather, was a physically operative entity that imposed a "physical organization" on data. 32 USPQ 2d at 1034. The court stated:

More than a mere abstraction, the data structures are specific electrical or magnetic structure elements in memory. ... [T]he data structures provide tangible benefits; data stored in accordance with the claimed data structures are more easily accessed, stored and erased... In short, Lawry's data structures are physical entities that provide increased efficiency in computer operation.

32 USPQ 2d at 1035 (emphasis added).

The claims of the present case, as in *Lawry*, recite data structures ("physical entities" according to *Lawry*) that also organize data (and data access and flow) so as to increase efficiency of access by programs and efficiency of processing and outcome. Consequently, the claimed data structures are patentable subject matter under §101.

As a point of note, the Manual of Patent Examining Procedure §2106 (a) cites *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ 2d 1754, 1760 (Fed. Cir. 1994) to stand for the broad proposition that a data structure per se is not patentable subject matter. *Warmerdam*, however, does not stand for this broad proposition. Instead, it simply

confirms that a recitation of a data structure that has no utility and linkage to physical applicability is not patentable. The data structures in *Warmerdam* were not stored for access by a computer program, and conferred no benefit. Therefore, they were considered unpatentable under §101. The claims in the current application, as amended herein, are not directed to a purely abstract, conceptual and non-useful data structures, but to a data structure (as well as method of organization, access and processing) stored so as to be accessed and processed by an application program in a computer, and provide real physical benefit of efficient data access and processing, with tangible and concrete useful results and benefits that are described above. Therefore, the current invention, as recited in the amended claims, constitutes appropriate patentable statutory matter under 35 U.S.C. §101.

Finally, the independent claims 1, 16, 31 and 69 are amended to clarify that the current model and data structures utilize a computer and data processing hardware to perform the task of analysis and assistance with insurance claim adjustments, assessment of recovery timeline, worker's compensation benefits and total costs, etc. (*See* Specification at pages 6 - 9, describing various hardware and database components of the current computerized system.)

Since the claims herein are appropriately directed to patentable subject matter, reconsideration of the §101 rejection is respectfully requested.

2. Rejection under 35 U.S.C. § 103(a)

In the Office Action dated December 17, 2004, the Examiner rejected claims 1-86 under 35 U.S.C. § 103(a) as being made obvious by the teachings of De Tore et al. (4,975,840), in view of Seare et al. (6,223,164) and Joao (6,283,761). The applicant respectfully disagrees with Examiner's analysis and points out that neither of those references, together or separately, teach the claimed invention/system, as it is recited in the amended claims and described in the specification.

The applicant notes that in the Office Action dated December 17, 2004, the Examiner agrees that De Tore and Seare "do not explicitly disclose at least one said body part from the time of injury over a specific progressive time scale into the future, due to at least one said condition, over time." (See Office Action, page 5, lines 6-8 (emphasis added.)) It is further noted in the same Office Action that Joao suggests this claimed feature at col. 38, lines 18-51. (See Office Action, page 5, lines 9-12 (emphasis added)). The applicant respectfully disagrees with Examiner's conclusion concerning Joao patent, and points out that the cited portion in Joao describes a training simulator for doctors or students. The user of this training system selects a particular training scenario and/or information, including the symptoms and /or conditions of a hypothetical patient and evaluates or offers a diagnosis and prescribed treatment. (See Joao, col. 38, lines 27-37.) This diagnosis is compared by the computer against any diagnosis which is known to be correct and/or scientific or statistical norms, and computes a revised set of symptoms and/or conditions that can result from the suggested treatment. (See Joao, col. 38, lines 38-47.) The suggested diagnosis/treatment and information about correctness

of that diagnosis/treatment is then recorded by the computer (*See* Joao, col. 38, lines 49-51.) In sum, Joao describes a computerized system to assist the doctor in reaching a diagnosis of injury or to confirm the existing diagnosis, and also mentions a treatment plan, given a particular diagnosis. It neither describes nor suggest, either alone or in combination with De Torre and Seare et al. the particular feature of the system invention, which uses predictive recovery over time (level of dysfunction over a progressive timeline) from time of injury for each body part and sub-part, and what impact that might have on the claimant's quality of life, timeline for recovery, the monetary value of current and future pain and suffering and loss of amenities of life and degree of possible recovery.

The applicant further reiterates the argument set forth in the prior Office Action response that neither De Torre nor Seare or Joao describe the particular type of profiles that are utilized and described in the current invention. Seare teaches a totally different use of profiles, comprising different information and aimed at different results. Seare describes a system for analyzing medical services utilization patterns. Its aim and purpose is concerned with analysis and optimization of treatments and associated costs, *i.e.*, how many doctors visits and what treatment are prescribed following a medical condition. *See* Seare col. 5, lines 38-44. It is concerned with determining whether the medical services rendered are usual and customary. Seare achieves this by providing "profiles" compiled statistically from a pattern of medical service, *i.e.*, historical collection of doctor's visits and rendered medical services. Each profile is built strictly

based on "an episode of care," which consists of all medical treatments and past visits to the doctor's office (or hospital). *See* Seare col. 23, lines 9-36. Unlike the current invention, there is no suggestion or requirement of providing and maintaining information concerning the (1) dysfunction of individual body parts, (2) estimates of their progressive recovery rate over time in the future, or (3) representation of injury and estimate of future recovery as dysfunction levels over time. Neither De Torre nor Joao, describe or suggest this feature, either alone or in combination with Seare.

In view of the foregoing amendments and remarks, applicant respectfully submits that the Claims 1-86 are in condition for allowance. Applicant hereby respectfully requests entry of this Amendment and an early favorable action on the merits.

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Respectfully submitted,

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